



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/532,283

09/01/2005

Joaquin Bigorra Llosas

C 2743 PCT/US

8759

23657 7590 11/25/2008

FOX ROTHSCHILD LLP  
1101 MARKET STREET  
PHILADELPHIA, PA 19107

EXAMINER

PALENIK, JEFFREY T

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,283	<b>Applicant(s)</b> BIGORRA LLOSAS ET AL.	
	<b>Examiner</b> Jeffrey T. Palenik	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-32 is/are pending in the application.
- 4a) Of the above claim(s) 14 and 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1615

### **DETAILED ACTION**

Receipt is acknowledged of Applicants' Amendments and Remarks filed 14 July 2008.

The Examiner acknowledges the following:

Claims 12, 15, 19 and 20 have been amended. Where support for the amendments was not expressly provided, it was found either within Applicants' disclosure and/or originally filed claims. The Examiner acknowledges that no new matter has been added.

Claims 14 and 21-32 which were previously withdrawn remain so still.

No claims have been cancelled and none have been added.

Thus, claims 12, 13, and 15-20 still represent all claims currently under consideration.

### **INFORMATION DISCLOSURE STATEMENT**

No new Information Disclosure Statement (IDS) have been submitted for consideration.

### **WITHDRAWN OBJECTIONS/REJECTIONS**

#### Objection to the Specification

Applicants' amendment to the Title of the Invention renders moot the objection to the Specification. Thus said objection is **withdrawn**.

#### Objection to the Claims

Applicants' editorial amendments to claims 15 (the chemical structure), and 19-20 (defining unit of measure), render moot the objections to claims 15, 19 and 20. Thus, said objections have been **withdrawn**.

Art Unit: 1615

Rejection under 35 USC 112

Applicants' amendment to the language of claim 12 renders moot the lack of antecedent basis rejection to claim 12, under 35 USC 112, second paragraph. Thus, said rejection has been **withdrawn**.

**MAINTAINED REJECTIONS**

The following rejections are maintained from the previous Office Action dated 14 March 2008:

**NOTE:** The Examiner realizes that the previous action directs the rejections made under 112, 2<sup>nd</sup> ¶, and 103(a), to claims 12-20 rather than 12, 13 and 15-20. This has been adjusted in the following maintained rejections. Claim 14 is still currently withdrawn from consideration.

**CLAIM REJECTIONS - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 13 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "the quantities add up to 100% by weight with water" and "optionally other electrolyte salts" render the claim indefinite. Since components (a) and (b), at most, comprise 55% of the composition, it is unclear what other components or amounts of other components comprise the remaining 45% of the composition.

Art Unit: 1615

The remaining claims are rejected since they depend from claim 12.

### **RESPONSE TO ARGUMENTS**

Applicants' amendment to the claim language (i.e. "the quantities add up to 100% by weight with water") in order to reconcile the second rejection to claim 12 under 35 USC 112, second paragraph, as being indefinite has been fully considered, but the amendment is not persuasive and the claim remains indefinite.

The amended claim 12 recites that the composition comprises components (a) through (d), further reciting: percent ranges for components (a) and (b), reciting (c) as being an optional component, and (d) as simply water [emphases added]. Given that the preparation comprises these four ingredients and further that one of the components remains optional, it remains unclear to the Examiner whether the "100% by weight" limitation refers exclusively to the weight of the components (a)-(d), the weight of the components (a), (b) and (d), or the weight of the entire concentrated preparation which comprises the components (a), (b), (d) and/or (c).

Thus, for this reason, Applicants' remarks and amendments regarding the claim are found unpersuasive. The above rejection is hereby maintained.

### **CLAIM REJECTIONS - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

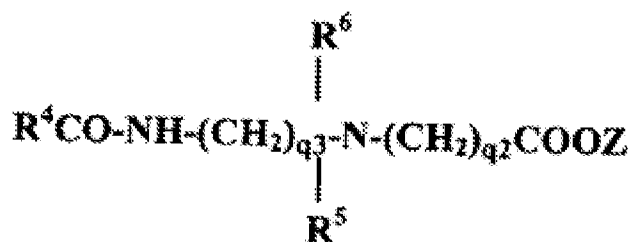
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

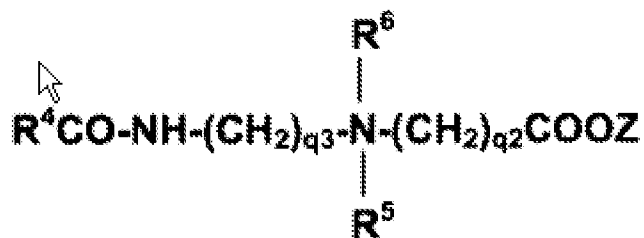
Art Unit: 1615

Claims 12, 13, 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bednall et al. (WO 95/14076).

The instant claims are directed towards a surface-active composition (e.g. a surfactant) comprising (a) an amphoteric or zwitterionic surfactant between 25-50% by weight and (b) at least one alkali metal sulfate between 0.01-5% by weight. The proviso set forth in the instant claim 12 is interpreted to mean that the quantities of the components added to create the composition represent 100% of said composition and that water is included as one of said components. Dependent claim 13, in accordance with the aforementioned species election, further limits the composition of claim 12 such that the surfactant is an alkyl amidobetaines. Dependent claim 15 recites the following general formula (II):



Given the aforementioned objection, the compound is interpreted to be:

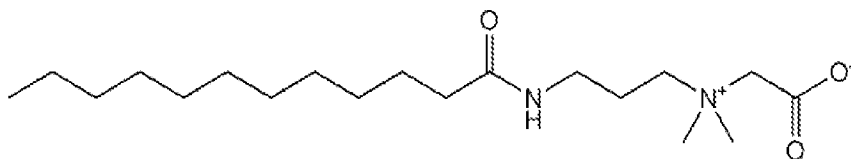


Claim 15 further specifies limitations to R<sub>4</sub>, R<sub>5</sub>, R<sub>6</sub>, q<sub>2</sub> and q<sub>3</sub>. The alkali metal sulfate is limited to either or a mixture of sodium sulfate and potassium sulfate in claim 16 and further limited to sodium sulfate in claim 17. Claim 18 further limits the percent range of sodium sulfate.

Art Unit: 1615

Claims 19 and 20 further limit claim 12 such that the composition is measured to be within a certain viscosity range.

Bednall et al. teach in Example 1, the preparation of the alkyl amidobetaine cocoamido propyl betaine (CAPB), which has the following structural formula:



The limitations of the structure are met:  $R_4$  is a  $C_{11}$  group,  $R_5$  and  $R_6$  are both methyl groups,  $q_2$  is equal to 1, and  $q_3$  is equal to 3. The CAPB active matter measures 40.2% w/w, sodium sulfate measures 0.3% w/w and contains water as well as the electrolyte sodium chloride (page 18). As to the viscosity range limitations recited in claims 19 and 20, since Example 1 teaches the composition as claimed, the claimed viscosity ranges are, therefore, inherently anticipated. MPEP 2112 states that “the fact that a characteristic is a necessary feature or result of a prior-art embodiment (that is itself sufficiently described and enabled) is enough for inherent anticipation, even if that fact was unknown at the time of the prior invention.” Therefore each and every element of the claims is met by the reference.

#### RESPONSE TO ARGUMENTS

Applicants' arguments with regard to the rejection of claims 12, 13 and 15-20, under 35 USC 102(b) as being anticipated by Bednall, has been fully considered, but is not persuasive.

Art Unit: 1615

Applicants argue that: (1) Bednall requires the presence of a water-miscible, non-surfactant organic solvent, (2) the non-colloidal electrolyte salts of Bednall are optionally discussed as opposed to being used to prepare the composition, (3) the presence of sodium salt and sodium sulfate in the final composition are due to the addition of other materials, and (4) that claim 12 as currently amended, is drawn to a composition which must exclude the organic solvents taught by Bednall because the instant composition must comprise 100% by weight of ingredients (a)-(d).

In response, the Examiner respectfully disagrees and submits that claim 12, as presently amended, does not clarify the contents of the instant composition, for reasons already discussed above. Thus, in view of the above reasons, it is possible that the preparation may comprise more than the ingredients (a)-(d), such as a water-miscible, non-surfactant organic solvent. Regarding the electrolyte salts: sodium chloride and sodium sulfate, despite the salts being discussed as optional additions to the composition in the specification, Example 1 does expressly teach both salts as constituents of the final composition, regardless of how their presence within said composition is achieved. Applicants' remarks against Bednall, for example, "the sodium sulfate in the final product arises from pH adjustment using sulfuric acid" are directed towards product-by-process limitations (MPEP §2113) and would hold no patentable weight since the end-product contains sodium sulfate. Furthermore, in response to Applicants' arguments that the references fail to show certain features of the instant invention, it is noted that the features upon which Applicants rely (i.e., viscosity due to non-surfactant organic solvent, product-by-process limitations, and percent range of water within the composition) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the



Art Unit: 1615

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus, for these reasons, Applicants' arguments are found unpersuasive. The above rejection is hereby maintained.

### **CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12, 13 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednall et al. (WO 95/14076).

The instant claims are directed towards a surface-active composition, as described above. Also, as described above claim 19 recites the composition as having a measured viscosity of less than 5,000 mPa-seconds and claim 20 recites the composition as having a measured viscosity ranging from 1,000 to 2,500 mPa-seconds. Bednall et al. teaches that the compositions of his

Art Unit: 1615

invention typically have a viscosity of “most preferably 700 to 6,000 centipoise at ambient temperature” (pg. 15, second paragraph under “Viscosity Characteristics”). A centipoise is equal to one millipascal-second (mPa·s) in SI units ( $1 \text{ cP} = 10^{-2} \text{ P} = 10^{-3} \text{ Pa}\cdot\text{s}$ ). Centipoise is properly abbreviated cP, but the alternate abbreviations cps and cPs are also commonly seen.

The reference does not teach the particular viscosity ranges claimed by Applicants. The particular viscosity of a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of such parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to adjust the components of the claimed surfactant formulation (e.g. water) to obtain the optimal viscosity value in order to best achieve the desired results of the instant invention. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of compositional viscosity would have been obvious at the time of Applicant's invention.

#### **RESPONSE TO ARGUMENTS**

Applicants' remarks regarding the rejections to claims 12, 13 and 15-20 under both 35 USC 103(a) as being unpatentable over Bednall have been fully considered, but are not persuasive.

Applicants allege that the rejection does not take into consideration the fact that it would not be reasonable to expect that the skilled artisan would be able to completely eliminate the organic solvent from the composition taught by Bednall, “[s]ince Bednall requires the presence of a water-miscible non-surfactant organic solvent to obtain the desired physical properties of the concentrated surfactant composition”.

Art Unit: 1615

In response to Applicants' argument that the references fail to show and/or take into consideration certain features of Applicants' invention, it is noted that the features upon which Applicants rely in their argument (i.e., the presence of a percentage of the organic solvent) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Rather the argument that the Examiner sets forth is that since Example 1 of Bednall teaches the claimed composition, further optimizing the composition to achieve a desired viscosity value of the claimed final composition, absent any evidence to the contrary, would be well within the purview of the skilled artisan. Applicants, to this point have provided no such evidence.

For these reasons, Applicants' arguments are found unpersuasive. Said rejection is therefore maintained.

All claims under consideration remain rejected; no claims are allowed.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1615

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey T. Palenik whose telephone number is (571) 270-1966. The examiner can normally be reached on 7:30 am - 5:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey T. Palenik/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615